

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HERON THERAPEUTICS, INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 22-985-WCB
)	
FRESENIUS KABI USA, LLC,)	
)	
)	
Defendant.)	

**JOINT MOTION AND [PROPOSED] ORDER
NARROWING CLAIMS AND COUNTERCLAIMS FOR TRIAL**

Pursuant to Federal Rule of Civil Procedure 15, Plaintiff Heron Therapeutics, Inc. (“Heron”) and Defendant Fresenius Kabi USA, LLC (“Fresenius”) hereby jointly move as follows:

WHEREAS, Heron filed a Complaint alleging infringement by Fresenius under 35 U.S.C. § 271 of, *inter alia*, U.S. Patent Nos. 9,561,229 (“the ’229 patent”) and 9,974,794 (“the ’794 patent”) (collectively, with the additional patents asserted in Heron’s Complaint, “Heron’s Asserted Patents”), based on Fresenius’s submission to the United States Food and Drug Administration of Abbreviated New Drug Application (“ANDA”) No. 214639 seeking approval to engage in the commercial manufacture, use, sale, or offer for sale of an injectable emulsion containing 130 mg/18 mL (7.2 mg/mL) aprepitant as described in said ANDA (“Fresenius’s ANDA Product”);

WHEREAS, Fresenius filed its Answer, Affirmative Defenses, and Counterclaims to Heron’s Complaint, including counterclaims for noninfringement and invalidity of Heron’s Asserted Patents;

WHEREAS, the Court granted Heron's motion for partial summary judgment on infringement of claims 1-11 of the '229 patent and denied Heron's motion for summary judgment on all other claims of the '229 and '794 patents (D.I. 150);

WHEREAS, no final judgment has been entered in the case, and the case is scheduled for trial commencing on June 24, 2024;

WHEREAS, in order to further streamline this case for trial, Heron now asserts the following five claims: claims 9, 10, and 21 of the '229 patent; and claims 9 and 10 of the '794 patent;

NOW THEREFORE, Heron and Fresenius, by their undersigned counsel, and subject to the approval of the Court, JOINTLY MOVE as follows:

1. Heron and Fresenius agree that no final determination has yet been reached in this action with regard to claims 1-8 and 11-20 of the '229 patent or claims 1-8 and 11-21 of the '794 patent.

2. Pursuant to Federal Rule of Civil Procedure 15, Heron hereby moves to dismiss with prejudice all claims that Fresenius's ANDA Product infringes Heron's Asserted Patents, except for claims 9, 10, and 21 of the '229 patent, and claims 9 and 10 of the '794 patent.

3. Pursuant to Federal Rule of Civil Procedure 15, Fresenius hereby moves to dismiss with prejudice all counterclaims against Heron's Asserted Patents, except those relating to claims 9, 10, and 21 of the '229 patent, and claims 9 and 10 of the '794 patent.

4. For the avoidance of doubt, nothing in this Stipulation shall affect the assertion of claims and defenses by either party regarding claims 9, 10, and 21 of the '229 patent, or claims 9 and 10 of the '794 patent, which claims remain as asserted claims in this action and shall remain scheduled for trial commencing June 24, 2024.

5. In view of the Court's Opinion and Order (D.I. 150, at 12-14), including the determination as to wt/wt% calculations as used in the '229 patent, and solely for purposes of this litigation, the parties stipulate that Fresenius's ANDA Product infringes claim 21 of the '229 patent.

6. In view of the Court's Opinion and Order (D.I. 150, at 12-14), including the determination as to wt/wt% calculations as used in the '794 patent, and solely for purposes of this litigation, the parties stipulate that the sole remaining infringement dispute for claims 9 and 10 of the '794 patent is whether Fresenius's ANDA Product meets the "physically stable" claim limitation.

7. This Joint Motion and Order shall not act as an adjudication on the merits.

Dated: June 23, 2024

MORRIS, NICHOLS, ARSHT & TUNNELL
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SO ORDERED this ___ day of June, 2024.

WILLIAM C. BRYSON
UNITED STATES CIRCUIT JUDGE